

Application No. 09/994,492
Amendment dated June 27, 2005
Reply to Office Action of March 3, 2005

REMARKS

Claims 1-6, 8-14, 16-18, 21-23, 25-27, 30-35, and 43-47 are pending in the application. The Examiner rejected Claims 1-6, 8-14, 16-18, 21-23, 25-27, 30-35, and 43-47.

Specification

The specification has been amended to correct a minor typographical error. Specifically, Applicant has corrected the metric conversion of 0.125 inches for the thickness of joint spacers 20.

Claim Rejections – 35 U.S.C. § 102

The Examiner rejected Claims 1, 2, 4, 5, 8, and 13 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,716,057 (hereinafter "Rubin '057"). Applicant respectfully submits that Rubin '057 does not disclose or suggest a ligament cutter including a handle and a head having a distal end with a blade, the head connected to the handle and the head having a radius of curvature, as called for in independent Claims 1, 4, and 8.

Rubin '057 discloses a chisel designed for cutting bony tissue including handle or shaft portion 10 terminating in blade 12 at one end thereof, as shown in Fig. 1. Blade 12 is formed with protuberances 16 and includes cutting edge 14 at its central portion. Nowhere does Rubin '057 disclose or suggest including a head having a radius of curvature. Because Rubin '057 does not disclose or suggest a ligament cutter including a handle and a head having a distal end with a blade, the head connected to the handle and the head having a radius of curvature, as called for in independent Claims 1, 4, and 8, Applicant respectfully requests withdrawal of the 35 U.S.C. § 102(b) rejection of Claims 1, 4, and 8, as well as Claims 2, 5, and 13 depending therefrom.

Claim Rejections – 35 U.S.C. § 103

The Examiner rejected Claims 3, 6, and 9 under 35 U.S.C. § 103(a) as being unpatentable over Rubin '057. Applicant respectfully submits that Claims 3, 6, and 9 are patentable for at least the reasons advanced above with respect to Claims 1, 4, and 8 from which Claims 3, 6, and 9 depend.

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The Examiner rejected Claims 10-12, 14, 16-18, 21-23, 25-27, 30-35, and 43-47 under 35 U.S.C. § 103(a) as being unpatentable over Rubin '057 in view of U.S. Patent No. 3,221,744 (hereinafter "Stryker '744"). Applicant respectfully submits that the Examiner has not established a *prima facie* case of obviousness based upon Rubin '057 and Stryker '744.

It is well settled that "the Examiner bears the initial burden of presenting a *prima facie* case of obviousness." *In re Rijckaert*, 9 F.3d 1531, 1532 (Fed. Cir. 1993) (citing *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992)). It is equally well settled that "a *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." *In re Rijckaert*, 9 F.3d 1531, 1532 (Fed. Cir. 1993) (citing *In re Bell*, 991 F.2d 781, 782 (Fed. Cir. 1993)). Stated another way, "(t)he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992) (citing *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984)). Not only must the Examiner bear the burden of showing a teaching or suggestion to combine references to establish a 35 U.S.C. § 103 obviousness rejection, but the Examiner must also indicate where such a teaching or suggestion can be found in the relevant reference. See *In re Yates*, 663 F.2d 1054 (CCPA 1981) (when the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference). Additionally, the Federal Circuit has counseled that "the suggestion to combine requirement stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness." *Yamanouchi Pharmaceutical Co., Ltd. v. Danbury Pharmacal, Inc.*, 231 F.3d 1339, 1343 (Fed. Cir. 2000) (citing *In re Rouffet*, 149 F.3d 1350, 1357-58, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998) (internal citations omitted)).

Applicant respectfully submits that neither Stryker '744 nor Rubin '057 contain a teaching, suggestion, or motivation for their combination. Stryker '744 discloses surgical knife 10 designed for use in removing the semilunar cartilage from a knee including blade supporting

head 12 as an integral extension of curved neck 13, as shown in Figures 1-3. Head 12 is of approximately the same thickness as neck 13 but is slightly broader to accommodate blade 14. Rubin '057 discloses a chisel designed for cutting bony tissue including handle or shaft portion 10 terminating in blade 12 at one end thereof, as shown in Fig. 1. Blade 12 is formed with protuberances 16 and includes cutting edge 14 at its central portion. The Examiner indicated that it would have been obvious to a person of ordinary skill in the art to modify Rubin '057 to include curved neck 13 as disclosed in Stryker '744. Applicant respectfully submits that there is no motivation to modify Rubin '057 to include curved neck 13 of Stryker '744.

Referring now to Appendix A, Figure I depicts the combination suggested by the Examiner including shaft portion 10 of Rubin '057 with curved neck 13 of Stryker '744 disposed at a distal end thereof. Figure II depicts the chisel of Rubin '057 with no modification. As shown in Figure II, a large portion of the Force (applied) to the chisel is transferred to the Force (blade) which is actually used to chisel a surface, *i.e.*, the Force (blade) includes a significant component substantially in the same direction as the Force (applied). In contrast, as shown in Figure I, the suggested combination requires a user to hold the instrument at an angle which causes a lesser portion of the Force (applied) to be included in the Force (blade) as compared to Figure II. As a result, the suggested combination in Figure I requires a significantly greater Force (applied) to get the same resultant Force (blade) as that shown in Figure II. Therefore, a person of ordinary skill in the art would not be motivated to modify Rubin '057 to include curved neck 13 of Stryker '744 because the efficiency and effectiveness of the resultant combination are significantly decreased.

Additionally, a person of ordinary skill in the art would not be motivated to modify Rubin '057 to include curved neck 13 of Stryker '744 because the additional size added to the chisel by curved neck 13 would be much more cumbersome for a surgeon using the instrument in the removal of nasal bone as described in Rubin '057. The nasal cavity is a confined space and a surgeon has little "spare" room to maneuver an instrument. The increased breadth and size imposed on the chisel by including curved neck 13 would significantly reduce the

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maneuverability of the instrument. Therefore, a person of ordinary skill in the art would not be motivated to modify Rubin '057 to include curved neck 13 of Stryker '744.

Furthermore, a person of ordinary skill in the art would not be motivated to add protuberances 16 of Rubin '057 to the surgical knife of Stryker '744. In essence, by adding protuberances 16 to the surgical knife of Stryker '744, probes 17 and 18 of Stryker '744 would be modified to have a thickness greater than head 12. Protuberances 16 of Rubin '057 are designed to prevent slippage of cutting edge 14. Applicant respectfully submits that there is no motivation to modify probes 17 and 18 of Stryker '744 to have a thickness greater than head 12. Probes 17 and 18 of Stryker '744 do not require a thickness greater than head 12 to guard against slippage of blade 14 because blade 14 is already protected from slippage via the recessed location of blade 14 within probes 17 and 18. Therefore, a person of ordinary skill in the art would not be motivated to modify Stryker '744 to include protuberances 16 of Rubin '057.

For all of the foregoing reasons, Applicant respectfully submits that the Examiner has not established a *prima facie* case of obviousness based upon Rubin '057 and Stryker '744. Therefore, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) rejection of Claims 10-12, 14, 16-18, 21-23, 25-27, 30-35, and 43-47.

It is believed that the above represents a complete response to the Official Action and reconsideration is requested. Specifically, Applicant respectfully submits that the current application is in condition for allowance and such action is earnestly solicited.

In the event Applicant has overlooked the need for an extension of time or payment of fee, Applicant hereby petitions therefor and authorizes that any charges be made to Deposit Account No. 02-0385, BAKER & DANIELS.

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If any questions concerning this application should arise, the Examiner is encouraged to telephone the undersigned at 260/424-8000.

Respectfully submitted,

BAKER & DANIELS



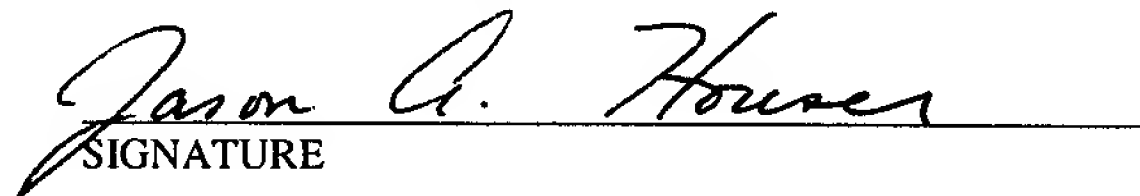
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June 27, 2005
DATE